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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/659,428	09/08/2000	Chhedi Lal Verma	FRB208	2946

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Horst M Kasper
13 Forest Drive
Warren, NJ 07059

EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT PAPER NUMBER

3623

DATE MAILED: 06/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

VACATED

(someone improperly
remailed paper no. 8)

Susanna
Diaz
8/17/03

Office Action Summary

Application No.

09/659,428

Applicant(s)

VERMA ET AL.

Examiner

Susanna M. Diaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This final office action is responsive to Applicant's amendment filed July 23, 2002.

Claims 12-17 and 20-27 have been amended by the Applicant.

Claims 11-27 remain pending for examination.

Response to Arguments

2. The declaration will remain objected to until Applicant submits a proper substitute declaration.

3. Applicant states that six figures were submitted with the "amendment dated June 12, 2000" (Page 8 of Applicant's response); however, the present application was not even filed until September 8, 2000. There are no drawings present in the instant application. Please submit drawings in response to the present office action.

4. In response to Applicant's argument regarding the incorporation of hyperlinks in the specification (Page 8 of Applicant's response), the objection to the specification is maintained because MPEP § 608.01 prohibits even printed versions of hyperlinks in the specification. Please amend accordingly.

5. The previously pending claim objections are withdrawn in response to Applicant's claim amendments.

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6. All rejections of the claims under 35 U.S.C. 112, 2nd paragraph are withdrawn (in response to Applicant's claim amendments), except for the rejection of claim 19 regarding its dependency from cancelled claim 1.

7. Applicant's arguments filed July 23, 2002 regarding the rejection under 35 U.S.C. 103(a) have been fully considered but they are not persuasive. More specifically, Applicant argues the following:

Thus claim 18 requires providing a presentation with price comparison of local merchants to a prospective buyer. In contrast Ziff-Davies 12 will bring computer buyers and sellers together in an interactive one stop shopping environment. There is nothing in Ziff-Davis about a presentation of a price comparison of local merchants where the products can be picked up afterwards. (Page 14 of Applicant's response)

In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Claim 18 stands rejected over Ziff-Davis *in view of* NetDynamics. It is the combination of these two references over which the claimed invention has been deemed obvious. Applicant has ignored the teachings of NetDynamics altogether; therefore, Applicant's arguments are non-persuasive.

All objections and rejections maintained from the previous office action (paper no. 6) are reproduced below for Applicant's convenience.

Declaration

8. The declaration is defective. A new declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The declaration is defective because it appears that neither of the inventors signed the declaration. Instead, "Sd--" is written on the signature lines of both inventors. Please submit a substitute declaration with both inventors' signatures.

Drawings

9. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81. Furthermore, the specification should be amended to make reference to the drawing(s) and all depicted reference numerals. No new matter may be introduced in the required drawing(s).

Specification

10. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 is dependent from claim 1, but claim 1 is cancelled; therefore, for examination purposes, claim 19 is assumed to be dependent from claim 18 instead.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 11-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Ziff-Davis Signs Up 189 Advertisers for the Coming Launch of Its Computer Shopper NetBuyer Web Site" (herein referred to as Ziff-Davis) in view of "Service Merchandise Uses NetDynamics to Move Its Entire Catalog Onto the Internet" (herein referred to as NetDynamics).

Ziff-Davis discloses a method for presenting a price comparison to a prospective buyer comprising:

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[Claim 11] collecting information from a plurality of merchants relating to data concerning products and respective price information (¶ 3, 12);

storing the information into records of a database (¶ 3, 12);

sorting the information relative to products based on the database (¶ 3, 12);

presenting the information in a plurality of records to the prospective buyer (¶ 3, 12);

[Claim 12] collecting the information from sales circulars, advertised specials, sales promotions, merchants (¶ 3, 7, 12);

collecting information relating to merchant name, merchant address, product description, model number, regular price, sales price, coupons, rebates, colors, or sizes (¶ 3, 7, 12);

entering attributes into a search key (¶ 3, 12);

entering geographical region, postal code, town name, county name, state name, product name, product category, model number, product description, price, product features, or brand name into the search key (¶ 3, 12);

[Claim 13] entering attributes into a search key (¶ 3, 12);

sorting the database according to merchant name, product name or model number (¶ 3, 12);

entering data for merchants offering a specific product into the database, wherein the data includes merchant name, product description, sales price, product description, sales price, coupons or rebates (¶ 3, 6, 7, 12);

providing access to the database through a browser interface (§ 3 -- "web-based").

As per claim 11, Ziff-Davis does not explicitly teach that merchant products compared and presented to customers on the Internet can be ordered online and picked up from a local store; however, NetDynamics makes up for this deficiency.

NetDynamics provides the following services through their affiliates:

Included with the expanded catalog are NetDynamics applications enabling customers to check to see if a product they want is available at their local Service Merchandise store. Customers will be able to reserve the item online before visiting the store to pick it up...

Rinat explained that all of this is made possible because NetDynamics enables the development of Web applications that tie into extensive data sources. In the case of Service Merchandise, these data sources include product listings, price, and availability. NetDynamics enables Service Merchandise customers to access this information over the Internet and then to purchase it through a secure transaction. (§ 6, 8)

Both Ziff-Davis and NetDynamics are concerned with providing a convenient Internet shopping experience to the customers; NetDynamics takes this concept one step further and fulfills many customers' need for immediate gratification (i.e., the ability to pick up a desired product from a local store). Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to implement the step of collecting information from a plurality of merchants relating to data concerning products in store locations and respective price information, wherein the prospective buyer is capable of visiting the store locations, with Ziff-Davis' Internet

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shopping system in order to reap the benefits of Ziff-Davis' product and price comparison features among multiple merchants while fulfilling many customers' need for immediate gratification (i.e., the ability to pick up a desired product from a local store).

Regarding claim 12, Ziff-Davis conveys the importance of allowing customers to search for products that meet the individual needs of each customer (¶ 3, 4); however, Ziff-Davis does not expressly disclose the sorting of its product database by price. The Examiner asserts that price is often a factor taken into account when customers shop for products that meet their needs; therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to sort Ziff-Davis' product database according to price in order to allow customers to more quickly narrow down their product selections to a more reasonable set of products that are the most likely to fit their needs (including their economic needs).

As per claim 13, the Ziff-Davis-NetDynamics combination teaches the concept of comparing desired products from different merchants via the Internet, ordering products online, and then picking up the products at a local merchant (as discussed above). In order for such a system to be operational, a customer must specify his/her location so that stores truly local to the customer can be identified. The Examiner submits that the use of a state to identify one's location (thereby implying one's local region) is old and well-known in the art; therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to request that a prospective buyer specify a state in which a desired product will be searched for and then pick-up, if available, as

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part of the Ziff-Davis-NetDynamics combination in order to allow a prospective buyer to quickly learn if desired products are available for pick-up locally (instead of forcing the prospective buyer to read through useless product inventory data from stores in remotely located states). Further, the notion of sorting a database by sales price was addressed above as well; therefore, the concept of presenting products in an ascending order based on sales price (as part of the Ziff-Davis-NetDynamics combination) would also have been obvious to one of ordinary skill in the art at the time of Applicant's invention in order to allow customers to more quickly narrow down their product selections to a more reasonable set of products that are the most likely to fit their needs (including their economic needs). Finally, as discussed above, the concept of sorting data provides a convenience to someone reviewing the sorted data; therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to allow a prospective buyer to sort product data as seen fit by the buyer (e.g., based on price, merchant name, etc.) in order to facilitate a quicker review of only the most pertinent products fitting the buyer's needs.

Regarding claim 14, Ziff-Davis does not explicitly disclose the use of a unique address corresponding to a geographical area-product combination; however, the Examiner asserts that the assignment of a unique web address corresponding to a particular geographical region is old and well-known in the art. This technique is helpful in reducing Internet traffic at a given web site. Therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to map the merchant and product data (of the Ziff-Davis-NetDynamics

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combination) to a unique address and present comparison data for a unique geographical area-product pair to the prospective buyer via this unique address in order to minimize Internet traffic build-up at a given web site. This will speed up each prospective buyer's Internet connection, thereby providing a more pleasant online shopping experience.

In reference to claim 15 and as discussed above, NetDynamics teaches the steps of checking inventory at a local store of a merchant upon request of a prospective buyer to determine availability of a chosen product and reserving the product at the local store for pickup after determining availability has been performed. Again, this shopping arrangement provides for the fulfillment of many customers' need for immediate gratification (i.e., the ability to pick up a desired product from a local store). Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to implement the steps of checking inventory at a local store of a merchant upon request of a prospective buyer to determine availability of a chosen product and reserving the product at the local store for pickup after determining availability has been performed with Ziff-Davis' Internet shopping system in order to reap the benefits of Ziff-Davis' product and price comparison features among multiple merchants while fulfilling many customers' need for immediate gratification (i.e., the ability to pick up a desired product from a local store).

Regarding claim 16, both Ziff-Davis and NetDynamics facilitate the payment of an ordered product via the Internet; however, neither reference expressly teaches

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payment through the use of either a registration token or a credit card number. The Examiner asserts that it is old and well-known in the art to make payments via the Internet using either a registration token or a credit card number; therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to incorporate the use of a registration token or a credit card number to order and pay for a product via the Internet (as part of the Ziff-Davis-NetDynamics combination) in order to facilitate convenient and secure Internet payments. Further, since the Ziff-Davis-NetDynamics combination teaches the online reservation of an item before picking it up, the ability to make payment via the Internet provides extra assurance to the merchant that the reserved item will be picked up by a customer. In other words, reserved items are confirmed sales as opposed to items merely put on hold that may or may not ever be picked up and paid for by the customer.

[Claim 17] Claim 17 recites limitations already addressed by the rejection of claims 11-16 above; therefore, the same rejection applies.

[Claims 18-22] Claims 18-22 recite limitations already addressed by the rejection of claims 11-16 above; therefore, the same rejection applies.

[Claims 23-27] Claims 23-27 recite limitations already addressed by the rejection of claims 11-16 above; therefore, the same rejection applies.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks
Washington D.C. 20231***

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or faxed to:


(703)305-7687 [Official communications; including
After Final communications labeled
"Box AF"]

(703)746-7048 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 22202, 7th floor receptionist.

SMD

August 8, 2002



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